REMARKS

Status of the Claims

Claims 1, 6-14, 19 and 22-24 are pending. Claim 1 is independent. Claims 22-24 are withdrawn from consideration as being directed to non-elected subject matter.

In the present Amendment, claims 1 and 13 have been amended. Claims 4-5 have been canceled herein, and claims 2-3, 15-18, 20-21 and 25 were previously canceled without prejudice or disclaimer of the subject matter contained therein.

No new matter has been added by way of the present amendments. Support for the amendment to claim 1 is found in, e.g., claims 4-5. With the amendment to claim 1, claim 13 was appropriately amended.

Reconsideration of this application, as amended, is respectfully requested.

Request for Entry of Response After Final Rejection

This response should be entered after a final rejection because it places the present application into condition for allowance. Further, the subject matter of claims 4 and 5, which appears in claim 1, has been previously considered.

In the event that this response does not place this application into condition for allowance, the Examiner is requested to enter this response because it places the application into better condition for appeal since, e.g., the number of claims is being reduced.

Priority under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Information Disclosure Citation

Applicants note that an Information Disclosure Statement was filed on May 16, 2011, which is after issuance of the latest Office Action. Applicants request consideration of the IDS and a returned, initialed copy of the PTO-SB08 form filed therewith.

Issues under 35 U.S.C. § 102(b) and § 103(a)

Claims 1, 4-6, 8-14 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ikuta et al. (U.S. Publication No. 2003/0118839; hereinafter "Ikuta '839") (Office Action, pages 2-3).

Also, claims 1, 7-14 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ikuta '839 (Office Action, pages 3-5).

These rejections are respectfully traversed.

A complete discussion of the Examiner's rejections is set forth in the Office Action, and is not being repeated here.

Applicable U.S. Case Law

Regarding anticipation, a prior art reference in order to anticipate under 35 U.S.C. § 102 must disclose those elements "arranged as in the claim," and not simply a disclosure of those

elements "within the four corners" of the single document. Further, this requirement, more accurately understood to mean "arranged or combined in the same way as in the claim," applies to all types of claims and refers to the need for the anticipatory reference to show all limitations of the claim arranged or combined in same manner recited in claim, not merely in particular order. *Net MoneyIN Inc. v. VeriSign Inc.*, 545 F.3d 1359, 88 USPQ2d 1751, 1758-1759 (Fed. Cir. 2008). Here, Ikuta '839 fails to disclose all claimed features as discussed below.

Regarding obviousness, such an inquiry is decided as a matter of law, based on four general factual inquiries as explained in *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966), and reaffirmed in *KSR Int'l, Inc. v. Teleflex, Inc.*, 550 U.S. 398, 406–07 (2007). Here, those *Graham* factors weigh in Applicants' favor, and a proper rationale has not been used to reject the disputed claims, as discussed below.

Ikuta '839 Fails to Disclose or Teach All Claimed Features and Advantages

Previously, in the Amendment of February 2, 2011, Applicants referred the Examiner to the claims on pages 22-23 and the disclosure on pages 10-11 of Ikuta '839 for its requirement of vulcanization. More specifically, Applicants argued that the vulcanized rubber in Ikuta '839 is not the same as the present invention's thermoplastic polyurethane elastomer. Further, Applicants argued that the rubber and resin of Ikuta '839 are bonded by vulcanizing and is not the same as the direct bonding or joining of the present invention. Also, Applicants referred to the unexpected properties of the present invention.

In the current Office Action, the Examiner maintains the rejections and refers Applicants to paragraph [00144] of Ikuta '839 as describing unvulcanized components (see, e.g., paragraph

41 on page 6 of the Office Action), and further states that the results in the present specification are not commensurate in scope with the claims (Office Action, paragraph 43 on page 6).

Applicants respectfully maintain that Ikuta '839 is improperly cited. Applicants note the cited paragraph [0144] of Ikuta '839, as well as the following paragraph [0146]:

> "[0144] Moreover, it is effective for bonding the resin member to the unvulcanized rubber member that a surface of the resin member is treated with a solvent capable of dissolving or swelling the resin member by a treatment such as coating or dipping, and the treated surface is contacted with the unvulcanized rubber composition. ...
>
> [0146] After treating the resin member with the solvent, even if the solvent is removed from the resin member by washing, drying, or other methods, the firmly bonding of the vulcanized rubber member to the resin member can be realized by contacting the treated surface of the resin member with the unvulcanized rubber composition."

(Emphasis added.)

Applicants also note Example 150 at paragraph [0332] of Ikuta '839.

Thus, based on entire reading of Ikuta '839, this reference fails to disclose the molded composite article in which the thermoplastic polyurethane elastomer directly bonds or joins to the specific non-urethane thermoplastic resin ((Ib-1) or (Ib-2)) as claimed.

Still, the Examiner states: "Ikuta teaches a broader method disclosure than submitted by Applicant. Specifically, at paragraph [0144] Ikuta teaches 'bonding the resin member to the unvulcanized rubber member' by treating a surface of the thermoplastic resin member with a solvent and further contacting the surface with the unvulcanized rubber member. Since the elastomer is unvulcanized, it remains a thermoplastic."

However, the cited paragraph [0144] of Ikuta '839 never discloses the unvulcanized rubber as bonding to the resin member. That is, paragraph [0144] of Ikuta '839 merely discloses that the pre-treatment of the resin with the solvent facilitates the bonding of the vulcanized

rubber with the resin member via vulcanizing. Therefore, even with pre-treatment, the unvulcanized rubber never bonds to the resin member. This is clear from the Ikuta '839 description of: "the firmly bonding of the vulcanized rubber member to the resin member can be realized by contacting the treated surface of the resin member with the unvulcanized rubber composition" in its paragraph [0146], as well as in its Example 150 at paragraph [0332].

The Examiner also points out in paragraph 44 of the Office Action: "Finally, the prior art, Ikuta, discloses polyamide resin and it is the examiner's position that the resin inherently has the amino group concentration presently claimed". However, as stated in the previous Amendment of February 2, 2011, Ikuta '839 is absolutely different from the present invention in terms of the mode of bonding as well as in concept. Therefore, even if *arguendo* the polyamide in Ikuta '839 has an amino group in a concentration of not less than 15 mmol/kg, the present invention which combines the thermoplastic polyurethane elastomer with the specific non-urethane thermoplastic resin and directly joins or bonds these resins without vulcanizing, could never be predicted or deduced from Ikuta '839 due to its required bonding via vulcanizing.

Therefore, Applicants respectfully submit that Ikuta '839 fails to disclose all claimed features, and that the rejection for anticipation and obviousness are improper. *Net MoneyIN Inc.; Graham; supra*. Ikuta '839 requires vulcanization, and is directed to a different concept versus the present invention.

Moreover, according to the present invention, as stated in the February 2 Amendment, the present invention does achieve unexpected results which rebut any asserted *prima facie* case of obviousness. Regarding any commensurate in scope issue, Applicants note the amendments

herein which specify the non-urethane thermoplastic resins (Ib-1) and (Ib-2). Thus, the data in the present specification does correspond to the instantly claimed invention.

Thus, reconsideration and withdrawal of these rejections are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez, Registration No. 48,501, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

By _____

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